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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,701	07/31/2003	David Wong	13914-028001 / 2003P00198	3616
32864	7590	02/01/2006	EXAMINER	
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			KYLE, CHARLES R	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,701

Applicant(s)

WONG, DAVID

Examiner

Charles Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-9, 12-21, 23-24, 27-32 and 34- 35 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,356,909 *Spencer*.

With respect to Claim 1, *Spencer* discloses the invention as claimed including in a computer-implemented method the steps of:

receiving user input to generate an opportunity representing a desired commercial transaction, the user input including opportunity data associated with the desired commercial transaction (Figs. 2, 13, 14; Col. 8, lines 5-38);

receiving user input to associate a particular compliance rule with the opportunity, the user input specifying a particular response attribute of a plurality of response attributes to be evaluated according to the particular compliance rule (Fig. 24, “radio button” responses; Col. 8, lines 5-38; Col. 14, line 42 to Col. 15, line 54, particularly Col. 14, lines 50-65) the user input further specifying the particular compliance rule of a plurality of pre-defined compliance rules

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(Fig. 15; Col. 8, lines 22-38; Col. 12, lines 28-39; Fig. 23, a plurality of predefined compliances rules (i.e., questions));

generating the opportunity using a computer-implemented bidding tool, wherein the opportunity includes the opportunity data, and wherein generating the opportunity comprises associating the particular compliance rule with the opportunity (Figs. 4, 21A; Col. 11, lines 3-35; Col. 12, lines 28-38; Col. 13, lines 19-44);

electronically communicating the opportunity to a potential supplier (Fig. 16; Col. 4, lines 40-49; Col. 8, lines 38-51);

electronically receiving a response from the potential supplier, the response including response attribute data for the particular response attribute (Fig. 21B; Col. 4, lines 49-52; Col. 9, lines 13-15); and

using a computer-implemented rules engine, evaluating the response attribute data for the particular response attribute using the particular compliance rule (Col. 3, lines 44-54; Col. 15, line 55 to Col. 16, line 5).

Applicant's argument in Remarks is that while *Spencer* discloses user selection of only one "compliance rule", which is read as questions put forth by an RFP creator to select vendors. This is incorrect. As shown in the additional citations to *Spencer*, the reference discloses a plurality of such compliance rules (questions for vendors in Fig. 23) to which there are plural response attributes (answers to the questions, shown in Fig. 24). Rules and attributes are selected by the user (RFP creator, as disclosed at Col. 14, line 42 to Col. 15, line 54, particularly Col. 14, lines 50-65, at least. Thus, *Spencer* does disclose limitations argued by Applicant. This is

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logical, as it would hardly be possible to effectively select among potential vendors using a single question.

With respect to Claims 2 and 4, *Spencer* discloses weighting of responses (an action) at Col. 3, lines 38-43, Col. 4, lines 7-12 and Col. 13, lines 11-18.

As to Claim 3, *Spencer* discloses flagging a response at Col. 16, lines 8-10.

With respect to Claim 5, *Spencer* discloses discarding a response at Col. 16, lines 10-15.

With respect to Claims 6 and 8, *Spencer* discloses a discard rule at Col. 16, lines 1-15; this is read as a processing rule.

As to Claim 9, *Spencer* discloses winner determination at Col. 16, lines 50-51.

With respect to Claim 12, *Spencer* discloses the invention as claimed including in a method the steps of:

receiving user input via a computer usable interface (Figs. 12-15) specifying a particular response attribute of a plurality of response attributes to evaluate using a compliance rule (Fig. 15; Col. 8, lines 22-38; Col. 12, lines 28-39; Fig. 23);

receiving user input specifying a particular compliance rule of a plurality of predefined compliance rules to evaluate attribute data for the particular response attribute (Fig. 15; Col. 8, lines 22-38; Col. 12, lines 28-39; Col. 14, line 42 to Col. 15, line 54, particularly Col. 14, lines 50-65; Fig. 23, a plurality of predefined compliances rules (i.e., questions)); and

receiving user input specifying an action to take based on evaluating the attribute data

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using the particular compliance rule (Col. 3, lines 38-43, Col. 4, lines 7-12 and Col. 13, lines 11-18).

See also the discussion of Claims 1 and 2.

With respect to Claim 13, *Spencer* discloses user input to associate a compliance rule with a later-created opportunity at Col. 8, lines 5-38. Here, questions are stored in the questions database for association with later-created RFPs.

With respect to Claim 14, *Spencer* disclose automatic determination of whether to associate a compliance rule with a later-created RFP at Col. 10, lines 58-65, in that editing of an existing RFP automatically specifies compliance rules (questions) with a new RFP (opportunity).

With respect to Claim 15, see the discussion of Claims 1 and 12.

With respect to Claims 16 and 27, they are the article and system variations of Claim 1 respectively and are rejected in a like way.

With respect to Claims 17 and 28, they are the article and system forms of Claim 2 respectively and are rejected in a like way.

With respect to Claims 18 and 29, they are the article and system forms of Claim 3 respectively and are rejected in a like way.

With respect to Claim 19, it is the article form of Claims 4 and is rejected in a like manner.

With respect to Claims 20 and 31, they are the article and system forms of Claim 5 respectively and are rejected in a like way.

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With respect to Claims 21 and 32, they are the article and system forms of Claim 6 respectively and are rejected in a like way.

With respect to Claims 23 and 34, they are the article and system forms of Claim 8 respectively and are rejected in a like way.

With respect to Claims 24 and 35, they are the article and system forms of Claim 9 respectively and are rejected in a like way.

With respect to Claim 30, it is the system form of Claim 4 and is rejected in a like manner.

Claims 7, 22 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0083156 A1 *Spencer* in view of US 2002/0165814 A1 *Lee et al.*

Regarding Claim 7, see the discussion of Claim 4. *Spencer* does not specifically disclose a weighting rule for assigning weights to a response. *Lee* discloses this limitation at paras. 31-35. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Spencer* with the weighting rules for attributes of *Lee* because this would result in improved ranking of alternative responses.

With respect to Claim 22, they are and 7 and are rejected in a like manner.

With respect to Claim 33, it is the system form of claim 7 and is rejected in a like manner.

Claims 10-11, 25-26 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0083156 A1 *Spencer* in view of US 2003/0208424 A1 *Tenorio et al.*

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With respect to Claim 10, see the discussion of Claim 1. *Spencer* does not specifically disclose evaluation based where the attribute is supplier identification. *Tenorio* discloses this limitation in a trading environment at para. 21. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Spencer* to include the supplier identification evaluation of *Tenorio* because this would allow buyers to receive responses from appropriate suppliers, such as those of a particular geographic area. See *Tenorio* at para. 21, lines 1-8.

With respect to Claim 11, see the discussions of Claims 4 and 10. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Spencer* with weighted supplier identification because this would result in improved ranking of qualified supplier responses.

With respect to Claims 25 and 36, they are the article and system forms of Claim 10 respectively and are rejected in a like way.

With respect to Claims 26 and 37, they are the article and system forms of Claim 11 respectively and are rejected in a like way.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant has asserted that there was common ownership of this application and the *Schulze* reference. While this issue is not currently relevant, given the citation of new art for rejection, the Examiner notes that records of the United States Patent and Trademark Office show no such common ownership.

Response to Arguments

Applicant's arguments filed November 28, 2005 have been fully considered but they are not persuasive. The arguments are addressed in the rejections set forth above with citations to *Spencer*.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk
January 23, 2006

Primary Examiner
Charles Kyle
Art Unit 3624

